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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,648	04/19/2006	Robert Stoiber	CE11457EP	8182
22917	7590	03/26/2009		
MOTOROLA, INC. 1303 EAST ALGONQUIN ROAD IL01/3RD SCHAUMBURG, IL 60196			EXAMINER JUNG, MIN	
			ART UNIT 2416	PAPER NUMBER
			NOTIFICATION DATE 03/26/2009	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Docketing.US@motorola.com

Office Action Summary	Application No. 10/576,648	Applicant(s) STOIBER ET AL.	
	Examiner Min Jung	Art Unit 2416	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 14-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 14-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-12 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory "process" under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state of thing (Reference the May 15, 2008 memorandum issued by Deputy Commissioner for Patent Examining Policy, John J. Love, titled "Clarification of 'Processes' under 35 U.S.C. 101"). The instant claims neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 14-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which

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was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 14 recites “an apparatus comprising a processor....” with the recitation of intended functions of the processor. This claim is a single means claim and is thus nonenabling for the scope of the claim because claim covers every conceivable structure for achieving the stated property. Further, applicant has not invented a processor, but has invented a method which can be implemented using a processor.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, it is not clear exactly what steps are taken for the selection method. It seems that the whole recitation sets up the intention and surrounding information, but fails to recite any positive method step.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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8. Claims 1, 2, 5, and 14-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Watanabe et al., US 5,991,642 (Watanabe).

Watanabe discloses mobile communication system having a control station which selects speech coding schemes for a mobile station. Regarding the present claim 1, Watanabe teaches a method for selecting a cell-based channel coding scheme, from a plurality of channel coding schemes (Watanabe teaches channel coding schemes A and B, col. 8, lines 50-53), for use in initiating communication with subscriber units in a cell of a communication system (communication system is shown in Fig. 1), wherein the selection of the cell-based channel coding scheme is dependant on information relating to channel coding schemes previously used for communication with subscriber units in the cell (the conditions relating to the speech coding schemes A and/or B are temporarily stored in the selection conditions table 80, and channel selection and control part 81 selects the type of speech coding scheme on the basis of the content stored in the table 80).

Regarding claims 2 and 5, Watanabe teaches the step of recording the channel coding scheme used for communication with at least a proportion of subscriber units in the cell (mobile stations 11-13) and the cell-based channel coding scheme is selected based on the recorded data (selection made by looking up the table 80).

Regarding claims 14-16, Watanabe teaches an apparatus comprising a processor (channel selection and control part 81) for selecting a cell-based channel coding scheme, from a plurality of channel coding schemes (Watanabe teaches channel coding schemes A and B, col. 8, lines 50-53), for use in initiating communication with

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subscriber units in a cell of a communication system (communication system is shown in Fig. 1), wherein the selection of the cell-based channel coding scheme is dependant on information relating to channel coding schemes previously used for communication with subscriber units in the cell (the conditions relating to the speech coding schemes A and/or B are temporarily stored in the selection conditions table 80, and channel selection and control part 81 selects the type of speech coding scheme on the basis of the content stored in the table 80). Watanabe further teaches a memory for storing information relating to channel coding schemes used for communication with subscriber units in the cell (global memory 82 including selection conditions table 80, Fig. 3).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 3, 4, 6, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe.

Regarding claims 3, 4, and 11, Watanabe fails to specifically teach recording the channel coding scheme used for each block of data in communication with subscriber units, and recording the channel coding scheme in use at the end of a communication with a subscriber unit. However, it would have been obvious for one of ordinary skill in the art at the time of the invention to implement the teaching of Watanabe with these

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details because the frequency of recording or the timing of the recording are the choices that a person skilled in the art can make by applying the common knowledge at hand.

Regarding claims 6, Watanabe fails to specifically teach selecting the channel coding scheme based on the channel coding scheme most commonly used in communication with subscriber units in the cell. However, it would have been obvious for one of ordinary skill in the art at the time of the invention to select the most commonly used coding scheme because such choice is an option open to system designer.

11. Claims 7-10, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe as applied to claim 1 above, and further in view of Budka et al., US 2003/0198312 (Budka).

Regarding claims 7-9, Watanabe fails to teach selecting coding schemes for uplink and downlink separately. Budka teaches selection of uplink coding scheme selection and downlink coding scheme selection in a separate process. See [0026]-[0034] and [0035]-[0046]. It would have been obvious for one of ordinary skill in the art at the time of the invention to implement the teaching of Watanabe by incorporating the separate uplink and downlink coding scheme selection as taught by Budka since it is known to have different communication parameters in uplink and downlink direction, and applying Budka's teaching in implementing Watanabe would provide the independent operation of uplink and downlink in Watanabe.

Regarding claims 10 and 12, Watanabe fails to teach selecting a more robust channel coding scheme in case the initiation using the selected channel coding scheme

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is unsuccessful. Budka teaches selecting a coding scheme, and to revise the decision as channel quality changes. See [0025]. Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to implement the teaching of Watanabe by employing the dynamic revision of decision of channel coding scheme as taught by Budka to provide dynamic adjustment feature in the coding selection scheme.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Rasanen patent, the Western patent, the Sekino et al. patent, and the Gopalakrishnan et al. PG Pub., are cited for further references.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Min Jung whose telephone number is 571-272-3127.

The examiner can normally be reached on Monday through Friday 9:00 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on 571-272-7872. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Min Jung/
Primary Examiner, Art Unit 2416